

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY ROBIN WHITE

Appeal 2007-0186
Application 09/939,491
Technology Center 1600

Decided: May 31, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and ERIC GRIMES,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claim 1, the only pending claim in this application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

Claim 1 reads as follows:

1. A new and distinct variety of Clematis plant named ‘Avalanche’ as described and illustrated.

The Examiner relies on the following evidence to show unpatentability:

European Union Community Plant Variety Rights Grant No. 4711 (August 15, 1999)

Bennett, *I.Cl.S. - The propagation of Clematis from cuttings - a discussion of some causes of failure*, The International Clematis Society Journal (1998), <http://dSPACE.dial.pipex.com/clematis/prop.htm>.

Appellant’s admitted sale of the Clematis plant named ‘Avalanche’ in the United Kingdom in the fall of 1998.

The rejection as presented by the Examiner is as follows:

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by European Union Plant Breeder’s Right’s Grant Number 4711 (4711).

We affirm.

DISCUSSION

The issue before us is whether evidence of a foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar. This specific issue was addressed in *In re Elsner*, 381 F.3d 1125, 1128, 72 USPQ2d 1038, 1041 (Fed. Cir. 2004), wherein our appellate reviewing court held in the affirmative. In reaching this conclusion, the *Elsner* court found that

[w]hen a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary

skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar. In any event, the inventor is in control of the activities relating to his invention, and avoidance of a bar is accomplished by making a timely filing at the PTO.

Id. at 1129, 72 USPQ2d at 1041.

In *Elsner*, the court found that “the precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date.” *Id.*, at 1129-30, 72 USPQ2d at 1042. In this regard, the *Elsner* court explained that “[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available.” *Id.*, at 1131, 72 USPQ2d at 1043. In addition, the *Elsner* court explained that “even if the interested public would readily know of the foreign sales, those sales [must] enable[] one of ordinary skill in the art to reproduce the claimed plants without undue experimentation. Such a determination is critical to the question whether the foreign sales would enable the printed publication.” *Id.*

In the Brief, Appellant’s arguments focused on the rationale in *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) (Br. 12-13). In particular, Appellant asserted that “[t]he court in *In re LeGrice* established a perfectly workable and rational approach for applying the policy and the language of 102(b) to this unique situation” (Br. 12). Appellant’s arguments

in the Brief suggested that *Elsner* is not controlling on the issue presented in this appeal. Accordingly, this Panel required Appellant to

clearly state the rule of law which supports Appellant's position that, in contrast to the holding in *Elsner*, the public use and availability of a plant variety outside of the United States is not material to a determination of the patentability of a plant variety in the United States under 35 U.S.C. § 102(b). . .

(Order¹ 6.) In response, Appellant directed our attention to *LeGrice* (Response to Order 2).

This Panel also required Appellant to “clearly state whether it *is*, or *is not* Appellant's position that *Elsner* is in conflict with *LeGrice*” and to clearly explain the basis for the position taken (Order 7). In response, Appellant stated that “Appellants [sic] believe that the holdings of *Elsner* are in conflict with *LeGrice*” (Response to Order 3). In Appellant's opinion, *LeGrice* “established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents” (*id.*). We are not persuaded by Appellant's arguments. This argument was specifically raised, discussed and dismissed in *Elsner*. The *Elsner* court found that their holding did not conflict with *LeGrice* which

decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant. In fact, there was no mention of sales in the *LeGrice* opinion. We therefore conclude that *LeGrice* left that issue open, and our decision today is not inconsistent with *LeGrice*.

¹ Order under 37 C.F.R. § 41.50(d), mailed March 1, 2007.

Elsner, 381 F.3d at 1130, 72 USPQ2d at 1042-43.

THE PRINTED PUBLICATION:

The filing date of Appellant's plant application is August 24, 2001. The Examiner finds that 4711 published on August 15, 1999, which is more than two years prior to Appellant's filing date (Answer 3). The Examiner finds that 4711 is open to public inspection; and "the Appellant, Breeder and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant" (Answer 3). 4711 describes the claimed plant variety, specifically the Clematis plant named 'Avalanche' (Answer 3-4). "The Community Plant Variety Office publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register" (Answer 3). "The register, grant and published applications are accessible to the public. This information was available on-line as well as in CD-ROM format . . ." prior to Appellant's filing date (Answer 3).

Based on this evidence, the Examiner finds that 4711 "is a 'printed publication' under 35 U.S.C. [§] 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981)" (Answer 3). We agree. Appellant does not dispute that 4711 describes the claimed plant variety. Instead, Appellant asserts that "[t]he Office stated that copies of these documents are not readily obtainable"; and "[i]f these documents are not readily obtainable by the U.S. Patent Office . . . [then they would be difficult to obtain by] an isolated plant breeder" (Br. 9-10). As discussed above, the

Examiner has clearly explained the manner in which 4711 and other information relating to the claimed plant variety were widely disclosed to the public, e.g., the information available was on-line, on CD-ROM and through the Community Plant Variety Office for the European Union (Answer 3-4). For his part, Appellant offers no evidence to support the assertion that a person of ordinary skill in the art, e.g., an interested plant breeder, would have been unaware of 4711 more than one year prior to Appellant's filing date. Appellant also fails to provide evidence or argument that 4711 and other information relating to the claimed plant variety was not widely disclosed to the public, including on-line, on CD-ROM, and through the Community Plant Variety Office for the European Union. Accordingly, we are not persuaded by Appellant's assertion.

THE FOREIGN SALE:

Appellant admits that the claimed Clematis plant named 'Avalanche' "was sold in the United Kingdom in the fall of 1998 (page 3 of reply filed September 17, 2002)" (Answer 3; Response to Request for Information² 2). According to Appellant, "a press release from The Guernsey Clematis Nursery Limited [(Press Release)] . . . states the launch of the plant to be in the spring of 1999" (Response to Request for Information 2). The Press Release also states that this "clematis is now available at a wide range of Garden Centres in the UK" and provides an address where interested parties

² Received June 7, 2005.

can request “more detailed information of where it can be obtained. . .”
(Press Release 1³).

Based on this evidence, the Examiner finds that Appellant admitted that the claimed plant variety was sold in the United Kingdom more than one year prior to Appellant’s filing date and that the sale did “not appear to be an obscure or isolated occurrence” (Answer 4). We find that the evidence on this record supports the Examiner’s finding regarding the sale.

Specifically, Appellant’s first appeal, Appeal No. 2003-2162, on the claimed subject matter was remanded to the Examiner to clarify, *inter alia*, the nature of Appellant’s 1998 sale (VACATUR AND REMAND 2-3 (we “remand the case to the [E]xaminer to determine whether the sales of the claimed plant (1) were ‘an obscure, solitary occurrence that would go unnoticed by those skilled in the art’. . .”). In response, the Examiner entered a Request for Information⁴ (Request) under 37 C.F.R. § 1.105 into the record requesting, *inter alia*, information relating to the sale of the claimed plant variety (Request 2⁵). In response, Appellant directs attention to the Press Release, and confirms that the claimed plant variety was sold in the fall of 1998 (Response to Request for Information 2).

On March 1, 2007 this Panel entered an Order under 37 C.F.R. § 41.50(d) (Order) into the record requiring Appellant to clearly explain, *inter alia*, “how the evidence on this record establishes that the admitted sale of the claimed plant should be considered ‘an obscure solitary occurrence that

³ This document is not paginated. For clarity, we have assigned consecutive page numbers to this document starting with the first page as page 1.

⁴ Mailed April 15, 2005.

⁵ This document is not paginated. For clarity, we have assigned consecutive page numbers to this document starting with the first page as page 1.

would go unnoticed by those skilled in the art’” (Order 7-8). In response, Appellant asserted that

[t]he sale of plants in the Fall of 1998 was to a single wholesale nursery for the purpose of building up a sufficient supply of plants to support commercial sales at a later date. The sale of plants in the Fall of 1998 was a single solitary occurrence that would not have been known to one skilled in the art.

(Response to Order under 37 C.F.R. § 41.50(d)⁶ (Response to Order) 5).

Appellant’s assertion is not persuasive. The evidence on this record establishes that the claimed plant variety was sold to Dailey Nurseries in the fall of 1998, and “to the public in the spring of 1999” (Response to Request for Information 2). Both of these sales were more than one year prior to Appellant’s filing date. The Press Release establishes that, at a minimum, the 1999 sale of the claimed plant to the public was not an obscure, solitary occurrence that would go unnoticed by those skilled in the art. To the contrary, the Press Release not only announces the intent to sell the plants in 1999, but it also announces that the plants were “now available at a wide range of Garden Centres in the UK,” and provides a contact address where interested parties can obtain further information.

We are not persuaded by Appellant’s hypothetical scenario regarding the propagation of the claimed plant in the United Kingdom. According to Appellant, since the claimed plant “was covered by a PBR grant, unlicensed propagation of ‘Avalanche’ would be an illegal act in the United Kingdom” (Response to Order 5). From this, Appellant posits that “[i]t is not logical for the U.S. patent office to require a hypothetical person to perform an act that would be illegal in a foreign country in order to reject a patent

⁶ Received April 5, 2007.

application in the United States” (*id.*). The evidence of record fails to support this argument. The evidence of record demonstrates that the claimed plant was sold to the public in 1999. There is no evidence that the propagation and sale of these plants was the result of an illegal act.

In addition, we are not persuaded by Appellant’s intimation that the claimed plant would not be available to a person skilled in the United States (Brief 12). There is no evidence on this record to suggest that the plants were not, or would not have been sold, to a person of skill in the United States.

We recognize Appellant’s assertion that “[t]he public use and availability of the subject plant variety outside of the United States is not material to a determination of ‘plant patentability’ of a plant variety in the United states under 102b [sic]” (Br. 10). Because this assertion is contrary to the holding in *Elsner*, we do not find it persuasive.

We recognize Appellant’s assertion that “[f]oreign asexually propagatable plant material . . . is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States [and] . . . imposes rigorous importation requirements” (Br. 12). This assertion appears to suggest that the regulations relating to the importation of plant material into the United States would have prevented a person of ordinary skill in the art from obtaining the claimed plant variety prior to the 102(b) date of Appellant’s application. Accordingly, this Panel required Appellant to “clearly explain how the evidence on this record establishes that United States importation requirements would have precluded a person of ordinary skill in the art from obtaining a foreign asexually . . . [propagatable] Clematis

plant material, as claimed” (Order 7). In response, Appellant asserted that “if one skilled in the art did follow the procedures specified by the Plant Quarantine Act of 1912, they would be adding an additional time period before plants were able to be imported into the United States” (Response to Order 4). While this may be true, we find no evidence on this record to suggest that a person of skill in the art would not have been able to obtain the claimed plant in the United States more than one year prior to Appellant’s filing date. Accordingly, we are not persuaded by Appellant’s assertion.

REPRODUCTION WITHOUT UNDUE EXPERIMENTATION:

The Examiner explains that Bennett “discloses how to asexually propagate clematis. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation” (Answer 5). We recognize Appellant’s assertion that “there is a very small window of time during the year during which Clematis ‘Avalanche’ can be successfully propagated” (Response to Order 5). There is, however, no evidence on this record that it would require undue experimentation for a person of ordinary skill in the art to reproduce the claimed plant variety according to the methodology set forth in Bennett. Accordingly, we are not persuaded by Appellant’s assertion to the contrary.

SUMMARY:

For the foregoing reasons, we find the facts of record on this record are very different than those in *LeGrice*, and therefore we find that *Elsner* is the controlling law on the issue before us on appeal.

We find that the evidence on this record establishes that a person of ordinary skill in this art would have known of 4711, the sources available for obtaining the claimed plant variety, and the methodology used to asexually reproduce the claimed plant variety. We find no error in the Examiner's use of secondary references to show that 4711 was enabled. *In re Samour*, 571 F.2d 559, 562-63, 197 USPQ 1, 4 (CCPA 1978).

There is no evidence on this record that the advertised sale of the claimed plant variety was an obscure, solitary occurrence that would go unnoticed by those skilled in the art. There is also no evidence on this record that a person of ordinary skill in this art would not be able to reproduce the plant without undue experimentation. As set forth in *Elsner*,

[w]hen a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

Elsner, 381 F.3d at 1129, 72 USPQ2d at 1041.

On reflection, we find that the weight of the evidence falls in favor of the Examiner. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b).

CONCLUSION

In summary, the rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed.

Appeal 2007-0186
Application 09/939,491

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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